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09/515,118	02/24/2000	Reuven Wachtfogel	NDS-4000 USA	7680

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EXAMINER	
TRAN, HAI V	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/515,118	WACHTFOGEL ET AL.	
	Examiner	Art Unit	
	Hai Tran	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-136* is/are pending in the application.

4a) Of the above claim(s) *1-69,74,77-106,108,110,118,120,128,130,131 and 133* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *70-73,75-76,107,109,111-117,119,121-127,129,132,134-136* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *All*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 05/25/2006 have been fully considered but they are not persuasive.

Amended claim 70, Applicant argues, "...neither Alexander et al. nor Schaefer et al describes or suggest either "determining condition pursuant to which viewing of said commercials may be obviated independently of user action", or "determining conditions pursuant to which viewing of said commercial is obviated by user action", as recited in amended claim70."

In response, the Examiner respectfully disagrees with Applicant because the above claimed limitations in met by Schaefer (Col. 4, lines 42-Col. 5, lines 8) for example if the status bit is NOT present, then the viewing of the commercial is obviated by user action user, i.e., FF. else if the status bit is present then the viewing of the commercial is obviated by user action user.

As to "determining condition pursuant to which viewing of said commercials may be obviated independently of user action", this limitations clearly reads on Alexander because, as self-admitted by Applicant, Alexander utilizes of viewer profile information to provide customized presentation of advertising to the viewer (see Applicant's remark page 10, last 2 lines). In view of that, Alexander clearly obviates commercials that do not fit viewer profile and independently of user action.

Furthermore, at least in one embodiment in which Schaefer broadcaster does not have any commercials/public service announcement/emergency broadcast need to be inserted into the television signal. In view of that, the user does not have to obviate (FF) any viewing of commercials/public service announcement/emergency broadcast because Schaefer 's provider obviates commercials/public service announcement/emergency broadcast by inserting nothing into the TV signal and independently of user action, as such there is no commercial/public service announcement/emergency broadcast in the receiving TV signal for user to obviate!

Claim 132, Applicant argues, "Akiba et al neither describes nor suggests "presenting alternative shortened versions of others commercials in response to a user request to view said one commercial in fast-forward or fast-backward mode". Again, as stated above, Akiba simply manipulates the manner of reproduction of frames in order to suppress the viewer's eye strain."

In response, the Examiner respectfully disagrees with Applicant because, as self-admitted by Applicant that "Akiba simply manipulates the manner of reproduction of frames in order to suppress the viewer's eye strain", it's clear that for example during a presentation of a series of commercials during a commercial break, if the user requests a fast-forward mode during the displaying of a commercial after the commercial break is detected by the system, Akiba system clearly generates/reproduces an alternative version of the series of presenting commercials by manipulating the reproduction of frames of the series of commercials in a manner to obtain a reproduction of the series of

a new version of commercials in the FF mode (different from the normal mode) that suppresses the viewer's eye strain. As such the Examiner maintains the rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 136 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 136 with limitation "wherein each alternative shortened version has a duration of exactly three second" is not described in Application specification 4th paragraph of page 32, as indicated by Applicant.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

The term "approximately" in claim 135 is a relative term, which renders the claim indefinite. The term "approximately " is vague and indefinite because the intended scope of the claim was unclear. It is unclear what the metes and bounds are of such a

term. Further clarification is required. Applicant is advised to carefully review claim 135 for compliance with 35USC§112, 2nd Paragraph.

The following art rejection is applied to applicant claims as best understood in view of the 112 2nd paragraph rejection above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 70-73, 76, 111-114, 116, 121-124 and 126 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US 6177931).

Claim 70, Alexander discloses a broadcast system comprising:

A headend for broadcasting program material with commercials (inherently); and

A multiplicity of receiver-decoders at user locations (inherently in order to provide Ads and EPG, as shown in Fig. 1), each receiving the program materials being broadcast and including a commercial unit (Col. 33, lines 8-Col. 35, lines 2) for dealing with the commercials based at least partially on past viewing thereof, wherein each the receiver-decoder deals with the commercials by determining conditions pursuant to which they are viewed by a user,

And the receiver-decoder deals with the commercials by one of the following:

Determining conditions pursuant to which viewing of the commercials may be obviated independently of user action (Alexander utilizes of viewer profile information to provide customized presentation of advertising to the viewer Col. 26, lines 57-Col.27, lines 7; Col. 32, lines 35-48. In view of that, Alexander clearly obviates commercials that do not fit viewer profile and independently of user action); and

Determining conditions pursuant to which viewing of the commercials is obviated by user action.

Claim 71, Alexander discloses a receiver-decoder (inherently in order to provide Ads and EPG, as shown in Fig. 1) for use with a broadcast system having a headend for broadcasting program material with commercials (inherently) and a multiplicity of receiver-decoders at a user locations (inherently), the receiver-decoder comprising a receiver for receiving the program material being broadcast; and

A commercial unit (Col. 33, lines 8-Col. 35, lines 2) for dealing with the commercials based at least partially on past viewing thereof, wherein the receiver-decoder deals with the commercials by determining conditions pursuant to which they are viewed by a user,

And the receiver-decoder deals with the commercials by one of the following:

Determining conditions pursuant to which viewing of the commercials may be obviated independently of user action (Alexander utilizes of viewer profile

information to provide customized presentation of advertising to the viewer Col. 26, lines 57-Col.27, lines 7; Col. 32, lines 35-48. In view of that, Alexander clearly obviates commercials that do not fit viewer profile and independently of user action); and

Determining conditions pursuant to which viewing of the commercials is obviated by user action.

Claim 72, Alexander discloses wherein said receiver-decoder deals with said commercials based at least partially on a history of viewing of said commercials via said receiver-decoder (Col. 34, lines 55-65+).

Claim 73 , Alexander further discloses wherein said receiver-decoder deals with said commercials based at least partially on a history of viewing of said commercials by multiple users (Col. 30, lines 38-45; Col. 33, lines 08-15).

Claim 76, Alexander further discloses wherein said receiver decoder deals with said commercials by determining conditions pursuant to which their viewing may be obviated independently of user action (Alexander utilizes of viewer profile information to provide customized presentation of advertising to the viewer Col. 26, lines 57-Col.27, lines 7; Col. 32, lines 35-48. In view of that, Alexander clearly obviates commercials that do not fit viewer profile and independently of user action).

Claims 111-112, method claims are analyzed with respect to system claims 70-71.

Claim 113, method claim is analyzed with respect to system claim 72.

Claim 114, method claim is analyzed with respect to system claim 73.

Claim 116, method claim is analyzed with respect to system claim 76.

Claims 121-122 are analyzed with respect to system claims 70-71.

Claim 123 is analyzed with respect to system claim 72.

Claim 124 is analyzed with respect to system claim 73.

Claim 126 is analyzed with respect to system claim 76.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 75, 107, 109, 115, 117, 119, 125, 127 and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (US 6177931) in view of Schaefer et al. (US 6490000).

Claim 75, Alexander further discloses wherein said receiver decoder deals with said commercials by determining conditions pursuant to which viewing of said commercials by user action (Col. 28, lines 30-60).

Alexander does not clearly disclose decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action.

Schaefer discloses the decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action (Col. 4, lines 42-Col. 5, lines 08). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with the teaching of obviating commercials, as taught by Schaefer, so to be more effectively control the process of allowing or not allowing user to skip commercials (Col. 1, lines 50-Col.2, lines 15).

Claim 107, Alexander does not disclose the receiver-decoder deals with said one commercial by preventing the user from skipping said one commercial.

Schaefer discloses the receiver-decoder deals with the one commercial by preventing the user from skipping the one commercial (Col. 14, lines43- 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with Schaefer so to insure that advertisements are viewed by the user (Col. 2, lines 1-8).

Claim 109 , Alexander does not disclose receiver-decoder deals with said one commercial by preventing the user from skipping said one commercial.

Schaefer discloses the receiver-decoder deals with the one commercial by preventing the user from skipping the one commercial (Co!. 14, lines43- 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with Schaefer so to insure the advertisements are viewed by the user (Col. 2, lines 1-8).

Claim 115, method claim is analyzed with respect to system claim 75.

Claims 117 and 119, method claim is analyzed with respect to system claims 107 and 109 respectively.

Claim 125 is analyzed with respect to system claim 75.

Claim 127 is analyzed with respect to system claim 107.

Claim 129 is analyzed with respect to system claim 109.

2. Claims 132, and 134-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al (US 6177931) in view of Akiba et al. (US 6377745).

Claim 132, Alexander teaches every limitations of claim 132 as discussed in claim 71.

Alexander does not specifically discloses "Dealing with the commercials, wherein, for at last one of the commercials, the dealing with the commercials comprises dealing with the one commercials by presenting alternative shortened versions of other commercials in response to a user request to view the one commercial in a FF or Fast-backward mode."

Akiba discloses the receiver-decoder deals with the one commercial by presenting a shortened version of said one commercial in response to a user request to view said program material in a fast-forward. If the FF function is not de-activated by the user, the system keeps presenting to user following commercials in sequence, one after the others (for example during a presentation of a series of commercials during a commercial break, if the user requests a fast-forward mode during the displaying of commercials right after the commercial break is detected by the system. In view of that Akiba system clearly generates/reproduces an alternative version of the series of presenting commercials by manipulating the reproduction of frames of the series of presenting commercials in a manner to obtain a reproduction of the presenting series of commercials in the FF mode that suppresses the viewer's eye strain; Col. 12, lines 53-Col. 13, lines 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with Akiba so to control the reproduction speed of which the video data are read out successively at a predetermined read out interval thereby suppress the user's eye strain with efficient retrieval of the video data, i.e., display commercials in a shorted version.

Claim 134, Alexander in view of Akiba further discloses wherein the alternative versions of other commercials comprise prepared meaningful shortened versions of a full commercials(reads on Akiba FF version of commercials that suppress the user's eye strain with efficient retrieval of the video data, as discussed

in claim 132. Indeed, Akiba FF version of commercials is meaningful to viewer because not all frames are suppressed).

Claim 135, Alexander in view of Akiba further discloses wherein each alternative shortened version has a duration of approximately three seconds (Since, Akiba' commercial FF version is a short version of a commercial. Thus, it is obvious that the Akiba 's commercial FF version is approximately to three second!)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht
08/04/2006

HAI TRAN
PRIMARY EXAMINER